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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/661,220   | 09/12/2003  | Jim E. Rainey        | 006560.P003         | 6821             |
| 26263 7590 01/29/2009<br>SONNENSCHN NATH & ROSENTHAL LLP<br>P.O. BOX 061080<br>WACKER DRIVE STATION, SEARS TOWER<br>CHICAGO, IL 60606-1080 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| RETTA, YIHDEGA   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 3622   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
| 01/29/2009   |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/661,220

**Applicant(s)**

RAINEY, JIM E.

**Examiner**

Yehdega Retta

**Art Unit**

3622

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-13, 22-26 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 14-21 and 27-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-13, 22-26 and 35-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election without traverse of November 13, 2008 in the reply filed on November 17, 2008 is acknowledged.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 recites the limitation "wherein the attribute is an attribute of a user who input the search string". The claim recites "a bid for a search string" but does not recite "a user inputting the search string". There is insufficient antecedent basis for this limitation in the claim.

Claims 22 and 35 also recite similar limitation and are also rejected as stated above.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9-13, 22-26 and 35-39 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Davis et al. (US 6,269,361 B2).

Regarding claims 9-13, 22-26 and 35-39, Davis teaches causing a bidding interface to be displayed on at least one display, the bidding interface comprising functionality to allow a bidder to bid for a search string and attribute combination; Wherein the attribute is an attribute of a user who input the search string; receiving at least one bid lot the search string and attribute combination. determining a winner of the at least one bid (see col. 19 line 27 to col. 20 line 55):

and associating an advertisement for the winner with the search string and attribute combination so that when the search string and attribute combination is input to a search engine, the advertisement is displayed together with a result of the search; wherein determining tile winning bid is based on a monetary amount of the bid (see fig. 7, col. 5 line 27 to col. 6 line 25, col. 8 line 63 to col. 9 line 27; wherein the bidding interface displays at least some of the bids that have been received for the search string and attribute combination (see fig. 9); wherein the attribute comprises a location in the form of a geographic location of the user; wherein the attribute comprises a location in the form of a network address of a computer of the user (see col. 17 line 60 to col. 18 line 11).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Meisel et al. (US 7,035,812 B2) teaches multi-element bidding for influencing position on a search result.

Colace et al. (US 6,826,572 B2) teaches allowing advertisers to manage search listing in a pay for placement system.

Kravets (US 6,704,727 B1) teaches generating search terms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/  
Primary Examiner, Art Unit 3622